

REMARKSClaim Rejections – 35 U.S.C. §102

Claims 1-8 stand rejected under 35 U.S.C. §102(e) as being anticipated by Rava et al. (US 6,690,966).

Directing Examiner's attention to MPEP 2131, the threshold issue under Section 102 is whether the Examiner has established a *prima facie* case for anticipation. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)". "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989).

Amended Claim 1 recites a system for analysis of an in vivo biological sample, comprising "...an unclad optical fiber operatively coupled to said middle infrared radiation source, said unclad optical fiber being substantially transparent in said spectral range of about 2.5 microns to about 20 microns, wherein said unclad optical fiber is a flexible and nontoxic silver halide fiber configured to be in direct noninvasive contact with said in vivo biological sample ...."

Applicant respectfully submits that Rava fails to disclose an unclad optical fiber operatively coupled to a middle infrared radiation source, wherein the unclad optical fiber is a flexible and nontoxic silver halide fiber configured to be in direct noninvasive contact with an in vivo biological sample, as recited by Claim 1. Examiner cites FIGS. 16A-B as disclosing the optical fibers of the present invention. However, the optical fibers 102, 122 and 124 in FIGS. 16A-16B are not unclad fibers configured to be in direct noninvasive contact with an in vivo biological sample. Instead, ATR elements 104, 106

and infrared reflector 106 are added onto the optical fibers of Rava. These ATR elements, not the optical fiber, are placed in contact with the tissue (Col. 13, lines 33-50).

Even if Examiner argues that the ATR element is part of the optical fiber, then the optical fiber does not qualify as being nontoxic. The ATR element is a ZnSe crystal (Col. 13, lines 1-3). As would be appreciated by one ordinarily skilled in the art, ZnSe, as with all selenides, is toxic enough to disqualify it from being considered nontoxic.

Furthermore, Applicant cannot find any mention in Rava of the optical fibers being silver halide fibers. Rava only describes the optical fibers as “standard quartz optical fibers.” (Col. 2, lines 50-51). Not only do standard quartz optical fibers not qualify as silver halide fibers, but they also do not qualify as being flexible as required by Claim 1. As would be appreciated by one ordinarily skilled in the art, standard quartz optical fibers are rigid, not flexible.

Therefore, Applicant respectfully submits that Claim 1 is not anticipated by Rava since Rava fails to teach each and every element of Claim 1.

Since Claims 2-4 depend from Claim 1, Applicant respectfully submits that Claims 2-4 are also patentable as they contain the same limitations as Claim 1.

Claim 5 was previously canceled in the Amendment dated November 7, 2005. Therefore, Applicant respectfully submits that the rejection of Claim 5 is moot.

Applicant respectfully submits that the same arguments made above with respect to the patentability of Claim 1 are applicable to the patentability of Claim 6 as well.

Since Claims 7 and 8 depend from Claim 6, Applicant respectfully submits that Claims 7 and 8 are also patentable as they contain the same limitations as Claim 6.

Therefore, Applicant respectfully submits that Claims 1-4 and 6-8 are currently in condition for allowance. Reconsideration and withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 U.S.C. §103

Claims 9 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rava.

Since Claims 9 and 10 depend from Claim 6, Applicant respectfully submits that Claims 9 and 10 are also patentable as they contain the same limitations as Claim 6.

Therefore, Applicant respectfully submits that Claims 9 and 10 are currently in condition for allowance. Reconsideration and withdrawal of this rejection is respectfully requested.

Amendments to the Claims

Applicant respectfully submits that the amendments to the claims find support in the specification as originally filed. Specifically, support is found on Page 12 of the specification. Therefore, Applicant respectfully submits that the amendments to the claims do not constitute new matter.

Applicant requests that this application be allowed. If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned attorney at 775-586-9500.

Respectfully submitted,  
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